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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/619,748

Filing Date: July 15, 2003

Appellant(s): MAU, ANDREAS

C. Gregory Gramenopoulos  
For Appellant

**EXAMINER'S ANSWER**

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

This is in response to the appeal brief filed 09/27/2007 appealing from the Office action mailed 05/09/2007.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

E-benefits website (downloaded from web archive.org).

20020049642	Moderegger et al.	4-2002
20020023212	Proudler	2-2002

20030229522

Thompson et al.

12-2003

MacSweeny, Gregory, "Billing System Drives Cross-Sell Efforts," *Insurance & Technology*, June 2003, Vol. 28, Issue 6, p. 23.

Singerman, Frederic S., "The Impact of the Electronic Signatures Act on Plan Administration," *Journal of Pension Benefits: Issues in Administration*, Autumn 2000, Vol. 8, Issue 1, pp. 3-8.

Tomsen, Mai-Ian, "Killer Content: Strategies for Web Content and E-Commerce," *Adison Wesley Lingman, Inc.*, Reading, Massachusetts, April, 2000, pp. 13, 129-133, and 177-180.

For the above reasons, it is believed that the rejections should be sustained.

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

##### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 31, 32, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the E-Benefits Inc. website (hereinafter E-Benefits) in view of Moderegger (US PG Pub# 2002/0049642).

A. As per claim 31, E-Benefits discloses a computer-implemented method for providing a distributed service marketplace (E-Benefits: pg 3, item 1, reads on "QuoteWizard will instantly search hundreds of...plans..."), the method comprising:

receiving, from a user, requirements for services (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to mean the user (employer) requirements (criteria), in order to be used, would have had to have been received from the employer);

electronically preparing a search message including the requirements for services (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to indicate preparation of an electronic search message which provides the requirements);

transmitting the search message to one or more service providers (E-Benefits: pg 3, item 1. The Examiner considers E-Benefits to be a form of service provider. The Examiner further considers the employer's provision of "search criteria" to be a form of transmitting a search message to a benefit provider.);

automatically receiving bids from the one or more service providers that satisfy the requirements for services (E-Benefits: pg 3, items 1 and 2. The Examiner considers an employer selecting from "available employee benefits options" to be a form of receiving bids from service providers. Furthermore, since the transmission and receipt of the bids are done by computer, the step is considered to be automatically);

sorting the received bids based on criteria selected by the user (E-Benefits: pg 3, item 2, reads on "comparing prices and benefits");

E-Benefits fails to explicitly disclose the remaining features of claim 1, however, these features are well known in the art as evidenced by the teachings of Moderegger who discloses

automatically selecting a best bid from the received bids based on the sorting (Moderegger: [0018]);

automatically transmitting a contract document to the service provider associated with the best bid (Moderreger: [0056]);

and

automatically receiving the contract document from the service provider associated with the best bid, wherein the contract document includes a status of at least one of

accepted (Moderegger: [0036]; [0057], reads on "awarding of a contract" and "contract has been awarded"),

rejected,

and

amended.

It would have been obvious at the time of the invention to one of ordinary skill in the art to combine the teachings of Moderegger and E-Benefits with the motivation of providing both a competitive bid based on price, as well as providing historical

performance data for a particular bidder to allow bidder performance to be considered as part of bid selection (Moderegger: [0019]-[0020]).

B. As per claim 32, E-Benefits fails to disclose the features of the claim, however, these features are well known in the art as evidenced by the teachings of Moderegger who teaches the method of claim 31, wherein

if the received contract document includes the status of accepted,

then the contract document further includes an electronic signature of the service provider associated with the best bid (Moderegger: [0041]; [0056]).

C. As per claim 39, E-Benefits discloses a method wherein the benefits comprise at least one of health care benefits, life insurance benefits, savings plans, stock option plans, pension plans, 401K plans, credit plans, flexible spending accounts, and claims processing for flexible spending accounts (E-Benefits: pg. 2, "QuoteWizard" section.).

D. As per claim 42, E-Benefits fails to explicitly disclose the features of the claim, however these features are well known in the art as evidenced by the teachings of Moderegger who discloses the method of claim 31, wherein the search message comprises

networking requirements including at least one of

memory specifications,

operating system specifications,

and

type of task to be executed (Moderegger: [0032], reads on “document and information exchange” and “databases...where bid- and performance-related information is respectively retained.”).

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of Proudler (US Pat# 2002/0023212, hereinafter Proudler).

A. As per claim 33, E-Benefits and Moderegger fail to teach the features of this claim, however, these features are well known in the art as evidenced by the teachings of Proudler who teaches the method of claim 31, wherein

if the received contract document includes the status of rejected (Proudler: [0077]),

then automatically selecting a next best bid from the received bids based on the sorting and repeating the automatically transmitting and automatically receiving the contract document steps with the next best bid. (The Examiner considers that just as duplicating of parts is considered obvious, so is duplication of a step obvious when the duplication fails to produce a new or unexpected result as in the present case. Thus given a list of bids and a process leading to the rejection of the first bid on the list, it would be obvious and expected to move onto the next bid and repeat the step until a bid is accepted. *In re Harza*, 274 F. 2d 669, 124 USPQ 378 (CCPA 1960).

5. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of MacSweeney (MacSweeney, Gregory. "Billing System Drives Cross-Sell Efforts." *Insurance & Technology*, June 2003; Vol. 28, Issue 6, pg. 23; hereinafter MacSweeney).

A. As per claims 34, 35, and 36 E-Benefits and Moderegger fail to disclose a method, further comprising:

receiving, from the employer, electronic payment for the benefits (claims 34 and 36);

receiving requests for payment for the benefits from the selected benefits provider (claim 35);

and

transmitting electronic payment for the benefits to the selected benefits provider (claim 36).

However, these features are well known in the art as evidenced by MacSweeney.

MacSweeney discloses a benefits provider who receives electronic payment (MacSweeney: col 2, 2<sup>nd</sup> paragraph, reads on “accepts electronic payments”; col. 3, 2<sup>nd</sup> paragraph, note “EFT”) for benefits from an employer (MacSweeney: col. 3, 2<sup>nd</sup> paragraph. Note “customers” making the payments are “benefit administrators”, which is read on by employer.) The Examiner notes that the way EFT works is for the customer (in this case a benefits administrator) to transmit funds electronically to a vendor (in this case, a benefits provider) who is set up to receive electronic payments.

MacSweeney also discloses an electronic billing system (MacSweeney: col. 2, 2<sup>nd</sup> paragraph, in particular “...a Web-based solution...that could provide customers with the ability to edit bills electronically...”). The Examiner considers Web-based bills to be

a form of a customer (benefits administrators/employers) receiving requests for payment from a benefit provider.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosures of MacSweeney with the method of E-Benefits in order to grow revenue (MacSweeney: col. 3, last paragraph).

6. Claims 37 and 38 are rejected under #5 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger and MacSweeney as applied to claim 36 above, and further in view of Singerman (Singerman, Fredric S. "The Impact of the Electronic Signatures Act on Plan Administration." *Journal of Pension Benefits: Issues in Administration*, Autumn 2000, Vol. 8, Issue 1, pp. 3-8; hereinafter Singerman).

A. As per claim 37, the collective teachings of E-Benefits, Moderegger, and MacSweeney fail to disclose receiving a carrier receipt from the selected benefits provider.

However, this feature is well known in the art as evidenced by Singerman (Singerman: pg. 6, from beginning of the section titled "DOL Authority" through the first bulleted point of the section.). Singerman discloses a method for plan administrators to comply with regulatory guidance concerning notification of plan participants by "using return-receipt electronic mail...to confirm receipt of transmitted information."

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Singerman regarding return-receipt email with the collective teachings of E-Benefits and MacSweeney in order to increase efficiency by electronically providing plan participants information required by law or regulation (Singerman: pg. 6, section titled "DOL Authority", first paragraph).

B. As per claim 38, the collective teachings of E-Benefits, Moderegger, and MacSweeney fail to disclose transmitting a carrier receipt to the employer.

However, this feature is well known in the art as evidenced by Singerman (Singerman: pg. 6, from beginning of the section titled "DOL Authority" through the first bulleted point of the section.). Singerman discloses a method for plan administrators to comply with regulatory guidance concerning notification of plan participants by "using return-receipt electronic mail...to confirm receipt of transmitted information."

The motivation for combining the teachings of Singerman with the collective teachings of E-Benefits and MacSweeney is as given above in the rejection of claim 37 and is incorporated herein.

7. Claim 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of Thompson et al (PG Pub No. 2003/0229522); hereinafter Thompson.

A. As per claims 40 and 41, E-Benefits and Moderegger fail to explicitly disclose a method comprising:

receiving, from the employer, a request to change (or stop) benefits for the employee;

and

transmitting, to the selected benefits provider, the request to change (or stop) benefits.

However, these features are well known in the art as evidenced by Thompson.

Thompson teaches an electronic system for benefits management (Thompson: Abstract and Fig. 1) where an employer can transmit a request to change (or stop) employee benefits which is received by a benefits provider (Thompson: [0206]; Fig. 2A, items 296, 300, and 302; note that request to change (or stop) employee benefits reads on "amendment request".) The Examiner considers change (or stop) requests to be specific examples of amendment requests.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method of E-Benefits with the teachings of Thompson to eliminate formerly paper-driven processes, thus improving productivity, reducing administrative expense, and improving data accuracy by removing human error (Thompson: [0012]).

8. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of Tomsen (Tomsen, Mai-Lan; Killer Content: Strategies for Web Content and E-Commerce; Addison Wesley Longman, Inc. Reading, Massachusetts; April, 2000; pgs 13; 129-133; and 177-180.; hereinafter Tomsen).

A. As per claim 43, E-Benefits suggests the method of claim 31, further comprising

providing a reimbursement to each of the service providers that provided the bids (E-Benefits: pg 3, item 3. The Examiner considers the step of "QuickEnroll" to include a payment from a purchaser to the selected benefit provider.).

E-Benefits in view of Moderegger fail to explicitly show this feature. However, this feature is well known in the art as evidenced by the teachings of Tomsen.

Tomsen discloses the implementation of an "affiliate program" where a first web site publisher pays a second for driving customer or user traffic to the first web site. Typically the payment is a percentage of a sale made by the first web site to a user who arrives at the first web site via a link provided on the second website (Tomsen: pg 13, first paragraph and boxed information at bottom of page). Some programs are not based on a transaction, but are used simply to drive up site traffic and increase brand recognition. So for instance, following the teachings of Tomsen, E-Benefits could place a banner on other benefits providers web sites and pay the providers for every user who links to the E-Benefits site from another benefits providers sites (Tomsen: pg 129, section labeled "Set Up Smart Affiliate Relationships", first paragraph).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tomsen with the method of E-Benefits, with the motivation being to widen the breadth of the E-Benefits net user base (Tomsen: pg 129, section labeled "Set Up Smart Affiliate Relationships", first paragraph).

9. Claims 44-58 are rejected for substantially the same reasons as provided above for claims 31-43.

**(10) Response to Argument**

Appellant makes essentially two arguments. The first, contained in paragraph VII A, beginning on pg 14 of the brief and referring to independent claim 31 is that in the limitation

"automatically receiving the contract document from the service provider associated with the best bid, wherein the contract document includes a status of at least one of accepted, rejected and amended,"

the feature of "the contract document includes a status of at least one of accepted, rejected and amended," is not taught by the Moderegger reference. In response, the Examiner points to Moderegger: [0056]. This passage describes the bid award process of the taught invention. If a bid is accepted, an electronic document is sent to the winning bidder indicating acceptance ("...transmits the award decision...informing the selected bidder that he/she has been awarded the contract."). Other contract documents are sent along with this such as the "contract list of performances" to be signed by the recipient. The Examiner considers this to be an example transmitting to contract document which includes an indication of acceptance. Thus the prior art teaches sending contracts including a "status of accepted" notification, and in combination with the E-Benefits reference teaches the entire claim.

Appellant's second argument is contained in paragraph VII B beginning on page 16 and referring to dependent claim 33. It is argued that part of the feature of

"if the received contract document includes the status of rejected, then automatically selecting a next best bid from the received bids based on the sorting, and repeating the automatically transmitting and automatically receiving the contract document steps with the next best bid."

is not taught by the Proudler reference, namely the recitation of, "...automatically selecting a next best bid from the received bids..." In response, the Examiner notes that Proudler: [0077] teaches accepting or rejecting a contract that meets the criteria of the requestor. If the contract is rejected, an iterative process is performed which amends the details of the contract so as to arrive at an acceptable agreement. The Examiner considers this second contract to be a type of "next best bid", which is subsequently selected as the contract.

The Examiner notes further that in order to select a next best bid no inventive step would be required other than to repeat the earlier step of selecting the best one, and that once the next best is selected, no new or unexpected result is produced, i.e. the result would be the same as if the first was selected. The Examiner considers that just as duplication of parts is considered obvious (see *In re Harza*, 274 F. 2d 669, 124 USPQ 378 (CCPA 1960), so is duplication of a step obvious when the duplication fails to produce a new or unexpected result as in the present case. Thus given a list of bids and a process leading to the rejection of the first bid on the list, it would be obvious and expected to move onto the next bid and repeat the step until a bid is accepted.

The same arguments made for claims 31 and 33 are made for the other independent claims and their dependencies, and the same reasons apply. For these reasons it is believed that the rejections should be sustained.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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